

PATENT
W&B Ref. No.: INF 2268-US
Atty. Dkt. No. INFN/WB0072

REMARKS

This is intended as a full and complete response to the Restriction Requirement dated June 17, 2005, having a shortened statutory period for response set to expire on July 17, 2005. Please reconsider the claims pending in the application for reasons discussed below.

Claims 1-28 are pending in the application. Claims 1, 4, 7, 13, 16, 20 and 23 have been amended. Applicants submit that the amendments do not introduce new matter.

Claims 1-28 stand restricted to one of the following inventions under 35 U.S.C. 121:

- I. Claims 16-22, drawn to a test system, classified in class 324, subclass 763.
- II. Claims 1-6, drawn to integrated circuit, classified in class 257, subclass 48.
- III. Claims 7-15, drawn to integrated circuit, classified in class 257, subclass 48.
- IV. Claims 23-28, drawn to method for testing an integrated circuit, classified in class 324, subclass 763.

Applicants provisionally elect, with traverse, the claims of Group II (claims 1-6) for examination. There are two criteria for a proper requirement for restriction between patentably distinct inventions: (A) The inventions must be independent; and (B) There must be a serious burden on the examiner if restriction is required. (MPEP § 803). Applicants submit that the Examiner has not properly established or satisfied the criteria for a proper requirement for restriction.

Regarding inventions of group I and group II, the Examiner states that the inventions are distinct, each from the other because:

"Inventions II and I are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP §

Page 7

381897_1

PATENT
W&B Ref. No. : INF 2268-US
Atty. Dkt. No. INFNWB0072

806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because combination does not require all the details of the subcombination such as an external test device for an activation signal and an electrical signal. The subcombination has separate utility such as by itself for its intended purpose or in a different combination."

Applicants respectfully submit that the Examiner has misapplied (i.e., reversed) the combination/subcombination relationship. As defined in MPEP 806.05(a), a "combination is an organization of which a subcombination or element is a part." With respect to Inventions II and I, Invention II is a subcombination of Invention I, and the particulars of the subcombination as claimed for patentability (as recited in independent claim 1) are also recited in the combination (as recited in independent claim 16). Therefore, the Examiner has not properly established the restriction requirement, and withdrawal of the restriction requirement is respectfully requested.

Regarding inventions of group III and group I, the Examiner states that the inventions are distinct, each from the other because:

"Inventions III and I are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because combination does not require all the details of the subcombination such as an external test device for an activation signal and an electrical signal. The subcombination has separate utility such as by itself for its intended purpose or in a different combination."

Applicants respectfully submit that the Examiner has again misapplied (i.e., reversed) the combination/subcombination relationship. With respect to Inventions III and I, Invention III is a subcombination of Invention I, and the particulars of the subcombination as claimed for patentability (as recited in independent claim 7) are also recited in the combination (as recited in independent claim 16). Therefore, the Examiner has not properly established the restriction requirement, and withdrawal of the restriction requirement is respectfully requested.

Page 8

381897_1

PATENT
W&B Ref. No. : INF 2268-US
Atty. Dkt. No. INFNWB0072

Regarding inventions of group II and group III, the Examiner states that the inventions are distinct, each from the other because:

"Inventions II and III are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because combination does not require all the details of the subcombination such as the switching signal. The subcombination has separate utility such as by itself for its intended purpose or in a different combination."

Applicants respectfully submit that the Examiner has again misapplied (i.e., reversed) the combination/subcombination relationship. With respect to Inventions II and III, Invention II is a subcombination of Invention III, and the particulars of the subcombination as claimed for patentability (as recited in independent claim 1) are also recited in the combination (as recited in independent claim 7). Therefore, the Examiner has not properly established the restriction requirement, and withdrawal of the restriction requirement is respectfully requested.

Although the Applicants provided comments above with respect to the combination/subcombination relationships between the invention groups I, II and III, Applicants do not concede that these invention groups may be subject to any restriction requirement, even if the proper combination/subcombination relationships were applied.

Regarding inventions of group I-III and group IV, the Examiner states that the inventions are distinct, each from the other because:

"Inventions I-III and IV are related as products and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the obvious method of operating the apparatus as claims 1, 7 and 16 is different from the method of claim 23."

PATENT
W&B Ref. No. : INF 2268-US
Atty. DKL No. INFN/WB0072

As recited in MPEP § 806.05(h), the required showing is that the product as claimed can be used in a materially different process (i.e., not merely "a different process"). Therefore, the Examiner has not properly established the restriction requirement, and withdrawal of the restriction requirement is respectfully requested.

Having addressed all issues set out in the Restriction Requirement, Applicants respectfully submit that the claims are in condition for allowance and respectfully request that the claims be allowed.

Respectfully submitted,



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